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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,497	01/24/2001	Jean-Marie Bernard	RN98105	8745

7590

03/27/2003

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/744,497

Applicant(s)

BERNARD ET AL

Examiner

Cephia D. Toomer

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002
- 2a) ☒ This action is **FINAL**      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 18, 22-27 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 18, 22-27, 29-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is in response to the amendment filed October 29, 2002 in which claims 18, 22-24, 32-34, and 36-37 were amended, and 19-21, 24, 28 and 38-39 were canceled.

The rejection of claim 33 under 35 USC 112 first paragraph is withdrawn.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendment to the claims.

The rejection of the claims under 35 USC 102 as being anticipated by Gras is withdrawn in view of the amendment to the claims and Applicant's arguments.

### ***Claim Rejections - 35 USC § 102***

1      Claims 18, 22-27 and 29-37 are rejected under 35 USC 102(b) as being anticipated by EP 822210. Claim 33 has been added to the rejection because applicant has overcome the 112 issue.

EP 822210 and US 6,291,624 are of the same patent family. Therefore, U.S. 6,291,624 will be used as a translation for the EP reference.

EP teaches coating (powder) compositions containing masked and unmasked isocyanate compounds. The isocyanate skeleton contains at least one polymethylene chain and at least two isocyanate functions. The isocyanates are derived from polyisocyanates made of the biuret type or those whose di-or trimerization reaction has produced 4-, 5- or 6- membered rings, such as isocyanuric rings (see abstract; col. 3, lines 36-65; col. 4, lines 3-12). EP uses a mixture of hexamethylene diisocyanate trimer

with IPDI trimer (see col. 4, lines 13-37). EP teaches that the isocyanate composition contains at most 5% of unmasked isocyanate compound and also that up to 1/3 mass of unmasked isocyanate trimers of cycloaliphatic monomers, such as IPDT may be added to the molten masked isocyanate compound in order to favorable effect the glass transition temperature (see col. 8, lines 8-44).

Accordingly, EP teaching all the material limitation of the claims anticipates the claim.

2. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that EP fails to teach a masked isocyanate compound having all of the following features; at least partially aliphatic, exhibits an aliphatic backbone which comprises at least one di-or polymethylene linkage and exhibits no masked isocyanate functional groups carried by an endocyclic cycloaliphatic carbon. Applicant also argues that EP fails to teach the additional use of a non-masked cycloaliphatic isocyanate compound.

EP teaches that the skeleton connecting the two isocyanate groups contains at least one polymethylene chain and that the masked isocyanate contains no endocyclic cycloaliphatic carbon (see col. 3, lines 36-65; col. 8, lines 15-27).

EP teaches at col. 8, lines 28-31 that the composition contains up to 5% unmasked isocyanate. While EP is concerned about reducing the amount of unmasked isocyanate, EP nevertheless teaches a composition containing a masked isocyanate

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compound and a non masked cycloaliphatic isocyanate compound, as is recited in the present claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

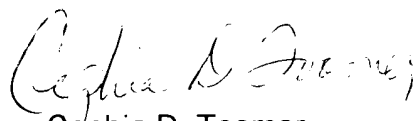
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

C. Toomer/mn  
March 25, 2003